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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,775	05/16/2001	Kazuki Matsui	1405.1043	9121
21171	7590	12/21/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			KIM, NICHOLAS J	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/855,775	MATSUI ET AL.	
	Examiner	Art Unit	
	Nicholas Kim	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>16 May 2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1-4, 6, 8, 11-13, and 15-16 are objected to because of the following informalities.

Claim 1 at line 8: “identifiers for the virtual spaces” should read “virtual-space identifiers”.

Claim 1 at lines 8-9: “identifiers for the symbols” should read “symbol identifiers”. Claim 1 at

line 18: “symbols; wherein” should read “symbols, wherein”. Claim 2 at line 5: “identifiers for

virtual spaces” should read “virtual-space identifiers”. Claim 2 at lines 6-7: “identifiers for

network resource symbols” should read “symbol identifiers”. Claim 3 at line 5: “levels of

interest in” should read “interest levels in”. Claim 4 at line 8: “similarity in” should read

“similarity in user”. Claim 4 at line 10: “computes level” should read “computes the level”.

Claim 4 at line 11: “in preference based” should read “in user preference based”. Claim 6 at line

4: “including:” should read “including a program configured to:”. Claim 8 at line 3: “method:”

should read “method comprising:”. Claim 8 at line 4: “storing identifiers for virtual spaces”

should read “storing virtual-space identifiers”. Claim 8 at line 6: “identifiers for network

resource symbols” should read “symbol identifiers”. Claim 11 at lines 10-11: “identifiers for the

virtual spaces” should read “virtual-space identifiers”. Claims 12 and 13 at line 3: “device of

claim 11” should read “device”. Claim 15 at line 4: “merchandise” should read “the

merchandise”. Claim 16 at line 14: “issue command” should read “issue a command”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Generally, the claims are narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Applicants are also reminded of the requirement of antecedent basis for claim limitations to precisely identify to which previous recitation a subsequent limitation refers. The extent of indefiniteness is severe enough to preclude an analysis of the claims for restriction/election.

5. For example, Claim 1 recites the limitation “mediating communications user terminals carry out sharing virtual spaces on a network” at lines 1-3. Claim 2 recites “where the user terminals participate mutually to communicate” at lines 5-6. Claim 7 recites “a network symbols prepared per merchandise item” at lines 6-7. Claim 8 recites “for mediating communications user among terminals on a network” at lines 1-2. Claim 8 recites “where the user terminals participate mutually to communicate” at lines 5-6. Claim 15 recites “which is made to correlate to” at line 9. Claim 16 recites “virtually installed on a network” at lines 2-3. Claim 16 recites “for inviting ... common merchandise” at lines 14-17. The meanings of these phrases are unclear.

6. Claim 10 recites “the symbols” at lines 4 and 10 and “the same symbols” at line 13. Claim 11 recites “the symbols” at lines 9 and 14, “the symbol identifiers” at line 11, and “the same symbols” at line 17. Claim 12 recites “the symbols” at line 4 and “the identifiers for the

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symbols” at lines 6-7. Claim 13 recites “the symbols” at line 5 and “the symbol identifiers” at line 7. It is unclear to which, if any, of the previous recitations of “the symbols” these limitations refer.

7. Additionally, Claim 1 recites the limitation "the reported virtual-space identifiers" at line 19. Claim 3 at line 12 recites “the received interest levels”. Claim 4 recites “the received symbol identifiers” and “the received level of similarity” at lines 14-15. Claim 9 at line 11 recites “received network resource symbol identifiers”. Claim 9 recites “the acquired virtual-space identifiers” at lines 15-16. Claim 14 recites “the predetermined preference data” at line 2 and “the symbols” at line 3. These claim limitations lack sufficient antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1-4, 6-13, and 15-16 are rejected under 35 U.S.C. 102(e) as anticipated by Bezos (U.S. Patent No. 6,525,747). It is noted that these rejections represent the examiner's best effort interpretation of the claims in light of the indefiniteness rejections described above.

10. Generally, Bezos teaches shopping (merchandise) related discussions (chat) conducted using hyperlinked (identifiers) text (symbols) among shoppers using a server (communication intermediating device) including tables based on Item/Participant/Discussion IDs (a correspondence table).

11. Beginning with Claims 1 and 10 (where Claim 10 is interpreted to be a "client-side" claim scope equivalent of Claim 1), Bezos teaches Applicants' claimed invention, including furnishing network resource symbols to the user terminals (FIG. 1); setting up in advance a correspondence table in which identifiers for the virtual spaces and identifiers for the symbols are correlated (FIG. 11 at 1105); providing an intermediating terminal enabling communication with the user terminals, and based on the correspondence table enabling conversion between the symbol identifiers and the virtual-space identifiers (FIG. 9 at 904); sending the symbol identifiers from the user terminals to the intermediating terminal (FIG. 1); and reporting from the intermediating terminal to the user terminals the virtual-space identifiers that correspond to the symbols (FIGs. 5-7, 12), wherein based on the reported virtual-space identifiers the user terminals participate in the virtual spaces and initiate communication with other user terminals having the same symbols (FIGs. 12-13).

12. With regard to Claims 2-4 and 11-13 (where Claims 11-13 are interpreted to be a "client-side" claim scope equivalent of Claims 2-4), Bezos discloses an intermediating device including a correspondence table correlatively storing identifiers for virtual spaces (FIG. 9 at 904), where

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the user terminals participate mutually to communicate, with identifiers for network resource symbols (FIG. 1); a first reception means for receiving the symbol identifiers from the user terminals (FIG. 9 at 904); and a first transmission means for transmitting to the user terminals the virtual-space identifiers that based on the correspondence table correspond to the received symbol identifiers (FIG. 9 at 904). Bezos also describes that the correspondence table correlatively stores the virtual-space identifiers, the symbol identifiers, and levels of interest in the symbols (FIG. 11 at 1105, for example, the number of discussion IDs per item); the first reception means receives from the user terminals the symbol identifiers and the interest levels (FIG. 9 at 904); and the first transmission means transmits to the user terminals the virtual-space identifiers that based on the correspondence table correspond to the received symbol identifiers and to the received interest levels in combination (FIGs. 12-13, joining discussion demonstrates interest level), thereby anticipating Applicants' Claim 3. Concerning Claim 4, Bezos also describes that the correspondence table correlatively stores the virtual-space identifiers, the symbol identifiers, and level of similarity in user preference for the symbols (FIG. 11 at 1105); the first reception means receives from the user terminals the symbol identifiers and predetermined preference data indicating the level of similarity in preference (FIG. 9 at 904); the first transmission means computes level of similarity in preference based on the preference data and transmits to the user terminals the virtual-space identifiers that based on the correspondence table correspond to the received symbol identifiers and to the received level of similarity in preference in combination (FIGs. 12-13, joining a discussion after being invited demonstrates similarity in preference).

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13. Bezos also teaches Applicants' Claim 6 and 9 (where Claim 9 is the "server-side" scope equivalent of Claim 6), including a step of acquiring via a network, and selectably displaying, network resource symbols (FIG. 1); a step of transmitting to an intermediating device identifiers for user-selected network resource symbols (FIG. 4); a step of receiving identifiers for virtual spaces that correspond to identifiers for network resource symbols transmitted based on a correspondence table in the intermediating device correlatively storing in advance network resource symbols with virtual spaces (FIGs. 5-7); and a step of connecting to a given virtual space based on identifiers in received virtual spaces, and initiating chat (FIGs. 12-13).

14. Addressing Claim 7, Bezos teaches preparing a correspondence table in which merchandise and virtual chat spaces for exchanging information on the merchandise are correlated in advance (FIG. 11); presenting to user terminals via a network symbols prepared per merchandise item in order to display the merchandise identifiably (FIG. 6); identifying merchandise symbols selected in user terminals (FIG. 11); acquiring and reporting to the user terminals information for identifying virtual chat spaces correlated based on the correspondence table to given merchandise (FIG. 8); and enabling in a one user terminal exchange of information on the given merchandise with other user terminals to begin (FIGs. 12-13).

15. Turning to Claim 8, Bezos describes correlatively storing identifiers for virtual spaces, where the user terminals participate mutually to communicate, with identifiers for network resource symbols (FIG. 11); receiving the symbol identifiers from the user terminals (FIG. 1); and transmitting to the user terminals the virtual-space identifiers that based on the stored data correspond to the received symbol identifiers (FIGs. 5-6).

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16. Concerning Claim 15, Bezos discloses selectably presenting to a user terminal a symbol prepared for each merchandise to identifiably display the merchandise via a network (FIGs. 1 and 7); obtaining and sending to a user terminal an identifier of a virtual chat space which is made to correlate to an identifier of a symbol and then stored when receiving an identifier of a symbol reported according to user selection (FIGs. 5 and 11); and connecting the user terminal to the virtual chat space to start to exchange messages with other user terminals (FIGs. 12-13).

17. Moreover, with regard to Claim 16, Bezos teaches preparing for each merchandise a chat space virtually installed on a network which invites users interested in relevant merchandise and a correspondence table where merchandise and a chat space corresponding the merchandise are correlatively stored (FIGs. 4-5); selectably presenting to a user terminal a symbol prepared for each merchandise to identifiably display the merchandise via a network (FIG. 6); identifying a symbol of merchandise selected by a user terminal (FIG. 11); and obtaining information for identifying a virtual chat space correlated to relevant merchandise according to the correspondence table to issue command for inviting relevant user terminal to relevant virtual chat space and starting communication between users having interest in common merchandise (FIGs. 11-13).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as unpatentable over Bezos in view of Aggarwal et al. (U.S. Patent No. 6,714,975, herein "Aggarwal").

20. Bezos does not explicitly teach that the predetermined preference data includes positional information on the symbols displayed on user terminals. However, Aggarwal expressly provides this limitation (Aggarwal at Col. 3, ¶. 47-50). Accordingly, it would have been obvious to one skilled in the art at the time of Applicants' invention to modify Bezos as taught by Aggarwal for advantageously exploiting "hotspots" and placement for optimum exposure (Aggarwal at Col. 2, ¶. 33-45).

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure. Herz et al. (U.S. Patent Pub. No. 2001/0014868) describes advantages of buyers' clubs for groups of shoppers with common interests. Eichner (Eichner, Matt, "Everyone's on the Same Page with iKena," PR Newswire, June 6, 2000, p.1) and Clark (Clark, Don, "Crowdburst Sees Web Browsing as Group Activity," Wall Street Journal, April 20, 2000, p.B.12) describe several software solutions enabling people to surf the web collaboratively including real-time chatting.


22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Kim whose telephone number is (571) 272-1392. The examiner can normally be reached on Monday - Friday 8am - 4:30pm.

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23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NJK



JEFFREY D. CARLSON
PRIMARY EXAMINER